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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,802	08/30/1999	KEVIN REMINGTON JOSEPH BARTHOLOMEN DONOVAN	4031/1	9671

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EXAMINER
JOHNSON, MARLON B

ART UNIT	PAPER NUMBER
2153	11

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)
Office Action Summary	09/385,802	BARTHOLOMEN DONOVAN, KEVIN REMINGTON JOS
	Examiner	**Art Unit**
	Marlon Johnson	2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>09 April 2003</u> .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-8,10-20,22 and 23* is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-8,10-20,22 and 23* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a) ☐ All b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

Detailed Action

Claim Rejections – 35 U.S.C § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Mozilla and in further view of Ogle et al. (6,430,604) and DeSimone et al. (6,212,548).

In considrering claim 1,

Mozilla discloses a distributed communication system in which a plurality of users

associated with different realms (protocols) access the Internet via a corresponding PC through a

service provider, a device for providing instant messaging between the users (lines 1-3 and 32-

35).

Although Mozilla shows substantial features of the claimed invention, he is silent in

regards to an IM manager associated with the PC of a first user and arranged to obtain a foreign

protocol for communicating with another realm (protocol) and being further arranged to receive

the unique identifier of a particular user associated with the another realm (protocol) from the

server and to establish connection to the other user using the foreign protocol, as well as an IM

server including a database with a listing of users currently connected to the Internet, each

having a unique identifier. However, Ogle et al. whose invention is a method for enabling

messaging systems to use alternative message delivery mechanisms, discloses such an IM

manager associated with the PC of a first user and arranged to obtain a foreign protocol for

communicating with another realm and being further arranged to receive the unique identifier of

a particular user associated with the another realm from the server and to establish connection to

the other user using the foreign protocol (see Fig. 3, Registry 300; col. 7, lines 56 to col. 8, line

28). Additionally, Maurille, whose invention is a method for providing threaded combinations of

instant messages, discloses such an IM server including an IM database with a listing of users

currently connected to the Internet, each having a unique identifier (see Fig. 1, Server 100, PMD

Database 108; col. 6, lines 44-57). Therefore, given the teachings of Ogle et al. and Maurille, it

would have been obvious for a person having ordinary skills in the art to modify Mozilla by

incorporating an IM manager and an IM server in to provide physical components that capable of

maintaining the instant messaging information.

In considering claim 2,

Ogle et al. discloses a device further comprising a local database arranged to store a

plurality of foreign protocols, each protocol being associated with a corresponding different

realm (see Fig. 3, Registry 300; Fig. 4, Transformation Engine 403).

In considering claim 3,

Ogle et al. discloses a device wherein said IM server is arranged and constructed to

connect to the Internet and to receive and transmit information to and from said IM manager via

the Internet (see col. 5, lines 51-62).

In considering claim 4,

Ogle et al. discloses a device wherein said IM database is arranged to store information

related to all said users (see Fig. 3, Registry 300; Fig. 4, Transformation Engine 403).

In considering claim 5,

Ogle et al. discloses a device further comprising a display arranged to show a list of

current friends of a user and a selector operated by said user to select a friend from said list to

establish communication (see Fig. 1, Display Device 24).

In considering claims 7 and 8,

Mozilla discloses a system wherein said users are arranged to communicate over the

Internet by different IM service providers (SPs) (see page 1, lines 32-35).

Additionally,

Maurille et al. discloses the IM database being incorporated into one of said SPs (see Fig.

1, Server 100; PMB Database 108).

3.   Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mozilla

and in further view of Ogle et al. (6,430,604).

In considering claims 6 and 16,

Mozilla discloses a distributed communication system in which a plurality of users

associated with different realms (protocols) access the Internet via a corresponding PC through a

service provider, a device for providing instant messaging between the users (lines 1-3 and 32-

35).

Additionally,

Ogle et discloses a first and a second device for operation by said first and second users

respectively, each device including a screen to display information, a selector or other input

device for giving and receiving commands and selections, a communication port arranged to

communicate with other users over the Internet, and an IM component arranged to establish IM

sessions during which said first and second users can exchange one of instant messages and other information over the Internet, said IM component including means for receiving a request for an IM session and means for generating a request for said IM session; said IM component including an IM database storing a protocol for the other realm (see Fig. 1; col. 4, lines 48-67; col. 6, lines 18-20 and 62-65; col. 7, lines 4-8; and 23-45); and

an IM database arranged to store a list of users registered to access instant messaging and being currently active together with their current location address (Fig. 3, Registry 300; col. 7, lines 56 to col. 8, line 28);

wherein said IM component is arranged to receive a command from said first user to establish said IM session with said second user and in response to said request said IM component is arranged to obtain the current address of said second user and to send an access request to said second user based on said address and said protocol and to establish said IM session if said access request is accepted (Fig. 3, Registry 300; col. 7, lines 56 to col. 8, line 28).

Although Mozilla and Ogle et al. show substantial features of the claimed invention, they fail to discloses using the IP addresses of the user for establishing communications between the users. Notheless, the use of IP addresses for uniquely identifier users is very well known in the art and would have been an obvious modification to the methods and systems disclosed by Mozilla and Ogle et al., as IP addresses are always used during any interactive communications session that is established using TCP or UDP . It would have been obvious for a person having ordinary skills in the art to modify Mozilla and Ogle et al. by using the IP addresses of the user for establishing communications between the users in to provide a standard-wide means for identifying different computer network users.

4.   Claims 10-15, 17-20, and 22-23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Mozilla and Ogle et al. as applied to claims 6 and 16 above, and further in

view of DeSimone et al.

In considering claims 10, 11, 22, and 23,

Although Mozilla and Ogle et al. show substantial features of the claimed invention, they

fail to disclose a system wherein each first and second device is arranged to display a window on

said screen, said window identifying a list of friends of the corresponding user, as well as the

first device being adapted to display a message area in one of said window and a separate

window. However, DeSimone et al. whose invention is a method and system for maintaining a

plurality of text chat conversations, discloses such a system wherein each first and second device

is arranged to display a window on said screen, said window identifying a list of friends of the

corresponding user, as well as the first device being adapted to display a message area in one of

said window and a separate window (see Fig. 7, GUI 700, Windows 710 and 720). Therefore,

given the teachings of DeSimone et al., it would have been obvious for a person having ordinary

skills in the art to modify Mozilla and Ogle et al. by allowing each first and second device to

display a window on said screen, said window identifying a list of friends of the corresponding

user, as well as the first device being adapted to display a message area in one of said window

and a separate window, in order to provide a GUI means for viewing the IM sessions.

Although Mozilla, Ogle et al., and DeSimone show substantial features of the claimed

invention, they fail to specifically discloses a list of friends who are currently online. Notheless,

the use of a list of friends who are currently online is very well known in the art and would have

been an obvious modification to the methods and systems disclosed by Mozilla, Ogle et al., and

DeSimone et al., as many lists have been in use for a while, such as AOL's buddy list. It would

have been obvious for a person having ordinary skills in the art to modify Mozilla, Ogle et al.,

and DeSimone et al. by using a list of friends who are currently online in to identify all possible

buddies who are available for a text session.

In considering claims 12, 13, and 14,

DeSimone et al. discloses a system wherein each said device is adapted to receive

commands from the respective user to establish a first IM session between said first user and said

second user and a second IM session between said first user and a third user, said third user

being identified in said window; wherein said first device is adapted to allow said first user to

switch between said first IM session and said second IM session, said first and second IM

sessions being active simultaneously; and wherein said first device is adapted to display in said

message area messages with said second user during said first IM session and messages with said

third user during said second IM session (see Figs. 5A-5C).

In considering claim 15,

Ogle et al. discloses a system wherein said first device is adapted to show characteristics

of said friends (see Fig. 3, Status/Constraints 303).

In considering claims 17 and 18,

Ogle et al. discloses a method wherein each time one of said first and second users access

the Internet, the corresponding device sends a message to an IM database indicating that the

corresponding user is on line and said current address, wherein said step of determining said

current address comprises retrieving said address from said IM database (see Fig. 3, Registry

300; col. 7, lines 56 to col. 8, line 28; Fig. 1; col. 4, lines 48-67; col. 6, lines 18-20 and 62-65;

col. 7, lines 4-8; and 23-45; Figs. 5A-5C).

In considering claims 19 and 20,

DeSimone et al. discloses a method further comprising sending a connection request from

the first to the second device for establishing said instant message session, as well as generating

a response to said connection request by said second device accepting said connection request

(see Figs. 5A-5C; col. 9, line 55 to col. 11, line 47).

Conclusion

5.   Applicant's request for reconsideration of the finality of the rejection of the Office Action

filed on 9/20/2002 is persuasive and, therefore, the finality of that action is withdrawn

6.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure (Morris et al. 6336133, Guck 5,848,415).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Marlon Johnson whose telephone number is (703) 305-4642.

The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Glen Burgess, can be reached on (703) 305-4792. The fax phone number for the

organization where this application or proceeding is assigned is (703) 305-3230.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-3900 .

Marlon B. Johnson

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